

## **REMARKS**

1. Applicant thanks the Examiner for pointing out the allowable subject matter of claims 6 and 21-25.

### **2. DRAWINGS**

The drawings are objected to because they are alleged not to show every feature in the claims. Specifically, the drawings are alleged not to show the liquid-tight seal described in claim 5 and the shielding element described in claim 6. Additionally, Figure is alleged not to show the lumens 113 described on page 8 of the specification. Applicant provides herewith a proposed correction to Figure 1 wherein the subject matter of claim 5 is added to Figure 1. Support for the amendment to the drawing is found at page 8, line 16 of the specification. Figure 1 is additionally amended to show a lumen 113. Applicant will submit a formal version of amended Figure 1 upon notification that the proposed amendment to Figure 1 is acceptable.

### **3. SPECIFICATION**

The specification is objected to because the control assembly 140 should be "130." The specification is amended to identify the control assembly with the correct reference character.

The specification is amended at page 11, lines 1-7 to describe "In a preferred embodiment, the electrodes 119 can be operated separately or in combination with each other as sequences of electrodes disposed in arrays." Support for the amendment is found at col. 5, lines 36-38 of the U.S. patent no. 6, 692,490, issuing from the parent application ser. no. 09/407,658. The subject matter was transferred from the claims to the specification during prosecution of the parent application. No new matter is added by way of the amendment.

### **4. 35 U.S.C. § 112**

Claim 5 is rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph as failing to comply with the enablement requirement. Specifically, the "liquid-tight seal of the

claim is not specifically recited or given an element number in the specification." Claims 5 and 6 have been amended to make clear that the liquid-tight seal is provided by the shielding element in claim 6. Support for the amendment is found at page 15, lines 2-8. The present rejection is therefore overcome.

Claims 1-11 and 15-25 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Each of claims 1, 11, 8 and 3 have been amended to eliminate the defects that cause them to be indefinite.

Claims 4, 6-7 and 21-25 are alleged to contain improper recitations of a Markush group. Applicant respectfully disagrees. While the manner in which the Markush group is recited does not conform exactly to the guidance given in the cited section of the MPEP, the present manner of reciting a Markush group has met with near-unanimous acceptance from the Examiner corps. Nevertheless, in the interest of advancing prosecution of the Application, the claims in question are amended to harmonize them with the Markush format described at MPEP § 803.03 [R-5]. The present rejection is therefore deemed overcome.

##### 5. 35 U.S.C. § 102

Claims 1, 3-4, 7-11, and 15-20 are rejected as being anticipated by U.S. patent no. 6,428,538 ("Blewett"). In order to describe the invention more clearly, claim 1 is amended to describe "selecting and activating said electrodes by an operator, individually and as sequences of electrodes disposed in arrays." Support for the amendment is found in the specification as amended above. Additional support for the amendment is found in U.S. patent no. 6,692,490 at col. 5, lines 36-38 and additionally in claim 1. Additional support for the amendment is found in original claim 2, now cancelled from the application. There is no teaching or suggestion in Blewett of the subject matter of claim 1 as amended. While Blewett does describe deployment of multiple electrodes, there is no teaching or suggestion in Blewett of a method wherein electrodes can be activated individually and as sequences disposed in arrays. The present rejection is therefore overcome. In view of their dependence from an allowable

parent claim, the dependent claims are deemed allowable without any separate consideration of their merits.

5. **35 U.S.C. § 103**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

Claim 2 is rejected as being unpatentable over Blewett. Although the present rejection is rendered moot by the above amendment to claim 1, and the cancellation of claim 2 from the application, even if claim 1 had not been amended, the present rejection would be improper. The Examiner asserts that the subject matter of claim 2 is well-known in the art. It is unclear whether the Examiner is relying on Official Notice or whether the Examiner is simply making an assertion of what is known in the art without producing documentary evidence for support. However, in either case, the Examiner must provide some technical rationale for making such a finding.

General conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. MPEP § 2144.03(B). Here, the Examiner provides a bald assertion that the deployment of electrodes independently of each other is well-known, without any further explanation or analysis, or any presentation of concrete evidence taken from Blewett or any other documents in the record. Applicant respectfully requests that the Examiner provide such documentary support for his assertion, either in the form of a reference or an affidavit.

Even if the subject matter were properly officially noticed, the present rejection would be improper because the Examiner has identified no motivation to combine the teachings from Blewett with the subject matter that is alleged to

be common knowledge. Accordingly, the present rejection is improper on this ground alone.

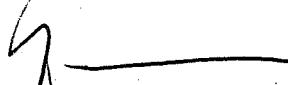
6. The above amendments are made in the interest of expediting prosecution of the Application. They do not indicate Applicant's agreement with the Examiner's position. Nor do they signify intent to sacrifice claim scope. Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in one or more continuing applications.

7. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

### **CONCLUSION**

In view of the foregoing, the Application is deemed in allowable condition. Accordingly, Applicant respectfully requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, he is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,



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